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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,998	04/14/2000	Richard C. Ebersole	BC1002 US NA	7991

23906 7590 06/25/2003

E I DU PONT DE NEMOURS AND COMPANY
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WILMINGTON, DE 19805

EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

29

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,998

Applicant(s)

EBERSOLE ET AL.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Receipt is acknowledged of a reply, filed April 15, 2003 as Paper No. 28, to the previous Office Action. Amendments were made to the claims. Specifically, claim 3 was cancelled

Claims 1 and 5 are pending and under consideration in the instant application. Any rejection of record in the previous Office Action, Paper No. 27, mailed March 26, 2003, that is not addressed in this action has been withdrawn.

Because this Office Action pertains to rejections that are either maintained for reasons set forth in the previous Office Action or that are necessitated by amendment, this Office Action is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This rejection is necessitated by amendment.**

Specifically, claim 1 iterates a period on the first line of section (b) of the claim, wherein it is unclear if this is meant to signal the end of the claim because there is still claim language that continues beyond the period. Furthermore, the claim does not end in a period if that period is not in fact the end of the claim.

Claim 5 recites the limitation "An isolated bacterial strain of claim 1" in the preamble of the claim. There is insufficient antecedent basis for this limitation in the claim. This is a direct

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result of the independent claim being drawn to an isolated nucleotide sequence, and not to an isolated bacterial strain. It is unclear if the claim is to be drawn to an isolated bacterial strain comprising the nucleotide sequence of SEQ ID NO: 8, an isolated bacterial strain that can be identified by SEQ ID NO: 8, or any bacterial strain meeting the functional limitation of being capable of dechlorinating activity. In the interest of compact prosecution, the claim is interpreted as being drawn to a bacterial strain capable of dechlorinating activity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Maymo-Gatell *et al.* (*Science* 176:1568-1571, 1997; see entire document; henceforth Gatell). **This rejection is both maintained for reasons set forth in the previous Office Action and necessitated by amendment.**

Specifically, claim 5 as amended in referring to a bacterial strain of claim 1 now encompasses any dechlorinating bacterial strain (see also the rejections under 35 USC 112, second paragraph).

Response to Arguments Concerning Claim Rejections - 35 USC § 102

Applicant's arguments filed April 15, 2003 have been fully considered but they are not persuasive. Specifically applicant argues that the Gatell reference does not teach every single element of the claimed invention, in view of the amendments to the claim, because Gatell does not specifically teach SEQ ID NO: 8 of the instant application.

Applicant's arguments are not convincing because the claimed invention, a bacterial strain comprising the specific sequence of SEQ ID NO: 8, is actually drawn to the bacterial strain which comprises said sequence, and not the sequence itself. The instant specification, in light of applicant's amendments, clearly sets forth that SEQ ID NO: 8 was identified in a specific bacterial strain DHE-195 (this represents the strain of *Dehalococcoides ethenogenes* isolated and characterized by Maymo-Gatell *et al.* (*Science* 176:1568-1571, 1997); see for example page 6, line 2 of the instant specification). Therefore, it is clear that DHE-195 comprises the sequence SEQ ID NO: 8. Similarly, Gatell discloses a bacterial strain capable of performing dechlorination, wherein that strain is DHE-195; in fact this is the original source of the strains used by applicant in the instant invention (see page 6, line 2). Because the strain of the instant application and the Gatell reference are identical, absent evidence to the contrary, Gatell must necessarily disclose a bacterial strain comprising SEQ ID NO: 8, wherein the strain is capable of dechlorinating a compound. Therefore Gatell does teach all of the elements of the instant claim 5.

Furthermore, in light of applicant's current amendment to claim 5, the claim now reads on *any* dechlorinating bacteria. Claim 5 now reads on a bacterial strain of claim 1, wherein claim 1 refers to a bacterial strain only in the context of it being a dechlorinating bacterium. There is

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no limitation indicating that the bacterial strain in claim 1 comprises or consists of SEQ ID NO:

8. This is especially true in light of the fact that claim 1 is directed to a nucleotide sequence, wherein the sequence can identify any dechlorinating bacteria, and not to a bacterial strain (see rejections under 35 USC 112, second paragraph). Because the claim now actually reads on any dechlorinating bacteria, Gatell is still anticipatory of claim 5.

Allowable Subject Matter

No claims are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
June 23, 2003


DAVID GUZU
PRIMARY EXAMINER